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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/10/2007

Lutz Freitag

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EXAMINER

YOUNG, RACHEL T

ART UNIT

PAPER NUMBER

3771

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/567,746	Applicant(s) FREITAG, LUTZ	
	Examiner RACHEL T. YOUNG	Art Unit 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/06, 10/30/07, 4/28/08, 5/15/08, 5/28/08,</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>6/25/08, 10/16/08.</u> | |

DETAILED ACTION

Drawings

1. The drawings are objected to because Figures 2 and 5 need to be in English. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Page 11, line 24 recites “support body 35”, which should be changed to --support body 36--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, line 2 recites "is recorded by sensors". Sensors do not record information so it is confusing as to how the "patient's spontaneous respiration" is being recorded. Claim 1, lines 2-3 recites "an additional quantity of oxygen". It is unclear if additional oxygen is administered after the patient has already received an amount of oxygen, or if this is the first amount administered. Claim 4, lines 3-4 recites "sensors are intended to record the patient's spontaneous respiration". Sensors do not record information so it is confusing as to how the "patient's spontaneous respiration" is being recorded. Claim 4, lines 6-7 recite "two of the sensors are assigned to the support body", but it is unclear as to how the two sensors are assigned.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill (2001/0035186 A1).

As to claims 1 and 3, Hill discloses a process for respiratory support for a patient (Page 2, ¶ 22), wherein the patient's spontaneous respiration is recorded by sensors (Page 4, ¶ 39, ll. 9-15), and an additional quantity of oxygen is administered to the lung at the end of an inhalation process (Page 6, ¶ 62, ll. 3-5), and that the patient's exhalation process is slowed by a counter-flow (Page 6, ¶ 62, ll. 5-6).

7. Claims 4-6 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Baran (5,964,223).

As to claim 4, Baran discloses an arrangement for respiratory support to a patient (Abstract) (Fig. 57), including an oxygen pump ("gas pump" 537) (Fig. 31) (Col. 31, ll. 19-20) to be connected to an oxygen supply (Col. 22, ll. 44-47), as well as an airway-prosthesis ("endotracheal tube" 948) (Fig. 57), to be connected via a catheter ("second catheter" 916) (Fig. 56) (Col. 35, ll. 38-49), wherein sensors ("first sensor" 960, "sensor" 964, "sensor" 968, "sensor" 976) (Fig. 57) are intended to record the patient's spontaneous respiration (Col. 36, ll. 19-38), same sensors being connected with a control unit ("controller" 1012) (Fig. 57) to activate the oxygen pump (Col. 37, ll. 14-18), and the airway prosthesis possesses a tubular support body ("endotracheal tube" 948) (Fig. 57) with a connector (where "flow control portion" 1013 attaches to the endotracheal tube in Fig. 57) for the catheter, wherein two of the sensors are assigned to the support body ("sensor" 964 and "sensor" 976) (Fig. 57) (Col. 36, ll. 19-38).

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As to claims 5-6, Baran discloses a sensor ("sensor" 964) (Fig. 57) is placed against the interior wall of the support body (Fig. 57), and that the end of the catheter ("second catheter" 916) (Fig. 56) which is located within the support body (Fig. 56) is redirected so as to be approximately parallel to its longitudinal axis (Fig. 56), as well as being provided with a jet nozzle (Col. 30, ll. 50-52) at its end.

As to claims 8-9, Baran discloses that the catheter is provided with a double lumen (ends of catheters 912 and 916) (Fig. 56), and further respiratory sensors are intended in addition to the sensors (Col. 36, ll. 19-38).

As to claims 10-12, Baran discloses an airway prosthesis ("endotracheal tube" 948) (Fig. 57) possessing a tubular support body ("endotracheal tube" 948) (Fig. 57) with a connector (where "flow control portion" 1013 attaches to the endotracheal tube in Fig. 57) for a jet catheter (Col. 30, ll. 50-52), wherein the support body includes at least two sensors ("first sensor" 960, "sensor" 964, "sensor" 968, "sensor" 976) (Fig. 57), and that a sensor is affixed to the internal wall ("sensor" 964) (Fig. 57) of the support body, and that the catheter end within the support body is directed so as to be parallel to its longitudinal axis (Fig. 56).

As to claims 13-15, Baran discloses a catheter ("second catheter" 916) (Fig. 56) as a tubular instrument to one of whose ends at least one sensor ("sensor" 960) (Fig. 57) is affixed, that the end possesses a jet nozzle (Col. 30, ll. 50-52), and that the end is bent (Fig. 56).

Claim Rejections - 35 USC § 103

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill.

As to claim 2, Hill discloses the claimed invention, but lacks detail regarding that the oxygen quantity has a volume of 25 ml to 150 ml. It would have been obvious to one having ordinary skill in the art at the time the invention was made such that that the oxygen quantity has a volume of 25 ml to 150 ml, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran in view of Adahan (4,807,616).

As to claim 7, Baran discloses the claimed invention, but is silent regarding that the oxygen pump consists of a piston pump. However, Adahan teaches that the oxygen pump consists of a piston pump ("motor" 14) (Fig. 1) (Col. 6, ll. 23-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Baran's pump such that it is a piston pump, as taught by Adahan, for the purpose of providing an ease of manufacturing.

Double Patenting

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11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 1-5 and 13-14 are rejected on the ground of statutory double patenting as being unpatentable over claims 1, 3, 5, and 9-10 of copending Application No.

12/271,484. Claim 1 has the same structure as the co-pending claim 1. Claim 2 is dependent on claim 1, which recite the same method steps as copending claim 3, which is dependent on claim 1. Claim 3 is dependent on claim 1, which recite the same method steps as copending claim 5, which is dependent on claim 1. Claim 5 is dependent on claim 4, which recite the same structure as copending claim 10, which is dependent on claim 9, which is dependent on claim 8, which is dependent on claim 7. Claim 14 is dependent on claim 15, which recite the same structure as copending claim 24, which is dependent on claim 23.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lampotang et al. (6,131,571) to a ventilation apparatus with flow control and respiratory sensors, Lynn et al. (2003/0000522 A1) to a monitoring system

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with a bi level ventilator and multiple respiratory sensors, and Truitt (6,644,311 B1) to a monitoring unit in a pressure support system using sensors and a bi-level ventilator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL T. YOUNG whose telephone number is (571)270-1481. The examiner can normally be reached on mon-thurs 7 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RACHEL T YOUNG/
Examiner, Art Unit 3771

/Justine R Yu/
Supervisory Patent Examiner, Art Unit 3771